

## **REMARKS**

Claims 1-22 and 26-30 are pending in the application and all of these claims currently stand rejected. Applicant has amended claims 1, 11 and 26 in response to the Examiner's rejections. Claims 23-25 stand withdrawn.

**The Examiner rejected claims 1-7, 11-13 and 16-21 under 35 U.S.C. 102(b) as being anticipated by Williams (4,302,962).** The Examiner stated that Williams discloses a leveling/inclinometer device that has all of the claimed elements of the instant leveling device and that the Williams device could be used with any structural device needing to be leveled. **In response**, Applicant respectfully disagrees firstly that Williams discloses all of the claimed elements of the instant leveling device and secondly that the Williams device could be used with any structural device needing to be leveled.

Williams does not disclose a device for vertically leveling a structural component but, rather, he discloses a device for testing leveling devices to see if they are calibrated correctly. As is disclosed in column 1, lines 19-21 of the patent:

*"This device provides for a true representation of the incline from true vertical of the tested inclinometer."*

(Emphasis added by Applicant)

In order for the Williams device to be used to conduct a test on an inclinometer, it has to be placed on a flat surface and be horizontally leveled so as to ensure that the device itself is not influencing the results of the tests. If the device is not horizontally leveled, the test results will be fairly meaningless because the results would not reflect the incline from true vertical, but would rather measure the incline from some other

undetermined angle. The Williams device is therefore provided with components to ensure that it is horizontally level, these components being the two bubble levels 36 and the adjustment screws 34 that are provided on the base plate 10. The testing device is placed onto a surface 35 and the screws 34 are selectively rotated until the two bubble levels 36 indicate that the base plate 10 is completely horizontally level. Once this has been established, then the tester manually sets the position of the arm 16 by physically moving the arm to a particular angle of between 0° and 15° as is indicated on the degree plate 40 and the tester then locks the arm into that position by tightening the thumb screw 20. This is disclosed in the patent in column 2, lines 61-63, where it is stated: *"The arm is moved to a predetermined angle relative to the vertical as indicated by pointer 38 relative to the degree plate 40."* and in column 1, lines 29-35, where it is stated: *"A thumb screw passes through the arms of the clamp and is tightened against the pivot shaft to provide a friction grip for the pivot shaft so as to permit the arm to be maintained at different predetermined angular positions relative to the vertical"*.

Once the arm 16 is locked at the predetermine angular position relative to the vertical, an inclinometer 28 is secured in place against the arm 16 as is shown in Fig. 3. The inclinometer 28 is then triggered to measure true vertical. The tester then compares the results produced by the inclinometer against the reading on the degree plate 40 and determines if the inclinometer is accurately calibrated. The part of the Williams device that actually indicates vertical levelness is NOT the arm 16 - it is the inclinometer 28 that is being tested that indicates vertical levelness. However, as is stated in column 2, lines 44-46 of the patent: ***"The details of the inclinometer form no part of the present invention and, hence, are not shown in the drawings"***. In other words,

Wilson states quite specifically that the component which indicates vertical levelness does not form part of his invention.

According to *Scripps Clinic & Research Found. v. Genentech Inc.*, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991):

“Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. . . . There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.”

(Emphasis added by the Applicant)

Applicant respectfully submits that a person of ordinary skill in the art would be able to distinguish between a device that is to be used to indicate levelness and a device for testing leveling devices. Applicant further respectfully submits that a person of ordinary skill in the art would be able to discern that a testing device wouldn't be attached to the side of a post to level the post. The likelihood is that the Williams device would be used in a controlled environment such as a laboratory or field office and would be used by a fairly sophisticated tester, whereas the leveling device of the present invention is used in the field by a person who is installing fence posts.

Furthermore, in accordance with the test described in the Scripps Clinic case referenced above, there should be no difference between the claimed invention and the reference disclosed, from the point of view of one of ordinary skill in the art. Applicant respectfully submits that apart from the manner in which these two devices are used, the Williams patent does not disclose a device that has a free swinging arm that would respond to changes in the vertical orientation of a fence post. The Williams device has an arm that is physically moved into a predetermined angular position and is then

secured in place to prevent it from moving - a feature that is very important for the operation of the testing device. Applicant submits that one of ordinary skill in the art would see a difference between the free-swinging arm and the arm that has to be locked into place.

Additionally, Applicant respectfully submits that one of ordinary skill in the art would be able to see that the Williams device could not be mounted onto a fence post without rendering the device inoperable for its intended purposed because it could no longer be horizontally leveled - its base plate 10 would hang in space and the screws 34 would have nothing beneath them to engage. Without the Williams device being horizontally leveled, the readings obtained from the test on an inclinometer would be worthless. Furthermore, Applicant submits that the necessary size of the Williams device would also strongly suggest to one of ordinary skill in the art that this device would not be a likely candidate for securing onto the side wall of a fence post for any purpose. In order to be able to test inclinometers, the Williams device would need to be sufficiently large enough to be able to lock various inclinometers therein. Attaching such a wieldy device to a fence post would be both difficult, time consuming and likely to cause damage to the fence post upon its removal therefrom. The claimed invention is designed to be mounted onto the side wall of a fence post and therefore would need to be sufficiently easy to handle, mount and, if so desired, remove.

In order to more clearly distinguish between the Williams testing device and the leveling device of the present invention, **Applicant has amended independent claim 1** to include the limitation that the base be adapted to be mounted on the side wall of the post. Applicant submits that the base of the Williams device, identified as 10/12 by the

Examiner, cannot be mounted on the side wall of a post without rendering the device inoperative with reference to its intended purpose. In order for the Williams device to operate, it has to be horizontally leveled so that when the arm 16 is locked into position, that position is meaningful and reproducible. If the Williams device was mounted to the side wall of the post it would not be able to be horizontally leveled because the screws 34 that adjust the position of the base plate 10, would be hanging in space and would not be able to engage a surface to adjust the angular position of the base 10 and thereby the position of the upwardly extending member 12.

**Applicant has further amended claim 1** by including the limitation that the arm mounted on the base pivots freely in response to movements in said post. As discussed above, the arm 16 on the Williams device is locked into position in order for the device to function. If on the Williams device, the arm 16 swung freely about its pivot 18, the device would cease to function as it could not be used to test inclinometers. As discussed above and in the Williams' patent, it is the inclinometer supported by locked arm 16 that measures vertical levelness. If the arm 16 and therefore the inclinometer could swing freely about the pivot - it would still be the inclinometer and not the arm that would indicate vertical levelness. Applicant submits that by Williams own disclosure, the arm is locked into place, it does not swing freely in response to movements of the post and consequently Williams does not anticipate amended claim 1.

Applicant therefore respectfully submits that Williams does not include each and every limitation of claim 1 and consequently this claim is not anticipated by the patent. Applicant therefore respectfully requests that the rejection of claims 1-7, 11-13 and 16-21 under 35 U.S.C. 102(b) as being anticipated by Williams be withdrawn.

**The Examiner rejected claims 8, 15, 26-30 under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Clearly (Great Britain 2,373,049).** The Examiner stated in the action that Clearly discloses employing a leveling device with a post as a base and shows the leveling device attached to the post by adhesive. The Examiner therefore stated that it would be obvious to one of ordinary skill in the art to employ any compatible leveling device with a post as taught by Clearly, i.e., that it would have been obvious to one of ordinary skill in the art to combine the Williams and Clearly references. **In response**, Applicant submits, firstly, that Williams is not a leveling device at all - it is a device for testing leveling devices as discussed above. Furthermore, Applicant submits that even if Williams is considered to be a leveling device it is not a leveling device that would be compatible with the teachings of Clearly. Clearly teaches a small bubble level that has adhesive on its rear surface so that it can be stuck onto a structural component and when that component has been installed, the bubble level can be pulled off of the same. The Clearly device is obviously small, unobtrusive and can be easily installed and easily removed. Williams, on the other hand, teaches a testing device that has to be placed on a horizontal surface in order to operate and that includes components which allow an inclinometer to be retained and tested thereon. As such, the Williams device would have to be sufficiently large enough to hold other devices in it and to allow a tester to manipulate the components in order to conduct a test. In order to use the Williams device in the sort of application taught by Clearly, the device would have to be secured to the structural component using screws or a large quantity of adhesive. This would make the installation of the Williams device on a post a time consuming and post-damaging operation. Furthermore, if the Williams

device was secured in the manner taught by Clearly, it would get in the way of the post installer because of its size and would make manipulating the fence post fairly difficult because of the additional weight at one end. These features would make the Williams device incompatible with the teachings of Clearly. Alternatively, the Williams device would have to be miniaturized in order to incorporate the teachings of Clearly. If this were done then the Williams device would no longer be useful for the purpose for which it was intended. In its miniaturized state the device would not be able to hold inclinometers for testing and the screws and the like for adjusting the angle of the arm and for leveling the base plate would be so small as to make it difficult to use. Furthermore, as discussed with reference to the previous rejection, it is not the Williams device itself that measures vertical levelness, it is an inclinometer that is received therein that would be used to indicate vertical levelness. It would be extremely difficult to include an inclinometer into a miniaturized Williams device. So, even in a miniaturized form, Applicant submits that the Williams device is not compatible with the teachings of Clearly as it would not function to indicate vertical levelness.

In the action the Examiner stated that for other limitations in claims 26-30, that the Applicant should review the 102 rejection.

With reference to some of the components identified by the Examiner in the 102 rejection, the Applicant has the following comments:

1. The Examiner stated that the Williams device has an L-shaped cross-section and is clearly capable of engaging a corner of a substantially rectangular or square post. Applicant submits that while the members 10/12 are oriented substantially at 90° to each other and therefore the

device is substantially L-shaped - that L-shaped device couldn't receive a corner of a rectangular or square post within the apex of the L-shape. This is because mounting the members 10/12 on a corner would cause the arm 16 to lie in abutting contact with one of the side walls of the post. This would render arm 16 immovable and the indicators and markers on the device would be unreadable. Furthermore, only the underside of base 10 and the rear wall of vertical column 12 would be visible to the post installer and absolutely no information as to vertical levelness would be obtainable from either of these surfaces as there are no markers or indicators on either of these surfaces.

2. The Examiner stated that each leg 10 and 12 has an arm 14 and 16, respectively, that is pivotally mounted thereon. Applicant submits that leg 10 and arm 14 can only be pivoted by element 34 if the free end of element 34 is in contact with a surface. If the Williams device was mounted to the side wall of a post so that the leg 12 was secured to the side wall, then the leg 10 would lie substantially at right angles to the side wall of the post and the element 34 would not be in abutting contact with any surface and therefore couldn't pivot any member of the Williams device. If, on the other hand, the Williams device was mounted on the side wall so that base 10 abuts the side wall of the post - then element 34 could be used to pivot base 10/14, but arm 16 would lie substantially horizontally and would be useless for indicating vertical levelness and would not be able to hold an inclinometer in an orientation where the



inclinometer could indicate vertical levelness. Consequently, the Williams device is not an L-shaped member that can be mounted to a post and have two pivotal arms mounted thereon that indicate vertical levelness.

3. The Examiner stated that each arm 14 and 16 are connected to a corresponding leg by a pin 34 and 16. Applicant respectfully points out that "pin" 34 does not engage "arm" 14 at all. This can be most clearly seen in Fig. 4 of the patent where the three "pins" 34 lie outwardly away from "arm" 14 and only engage base plate 10.
4. The Examiner stated that the v-shaped lower end of the arm of Applicant's device is used as an indicator and that the indicator/marker combination that Williams discloses with reference to base 10 is the bubble levels 36. In response, Applicant submits that the bubble levels 36 are mounted entirely on base 10, do not interact at all with arm 14. Furthermore, both the "indicator" and "marker" of bubble levels 36 are disposed entirely on the base 10. Neither of the indicator nor the marker of bubble levels 36 are located on the arm 14 as is required in the claims of the instant invention.
5. The Examiner stated with reference to the indicator 38 on the arm that "the apex aligns with the marker 40 when the structural device is vertical and does not align when the structural device is not vertical". Applicant respectfully submits that Williams does not use "a marker", Williams uses a plurality of markers - he has a scaled degree plate 40 that has a number of markings on it. Furthermore, the arm 16 on the Williams device does

not swing freely and align itself with true vertical as is the case with Applicant's arm - the arm 16 on the Williams device is moved into a particular orientation by the tester and is locked into place. If the arm is moved into a particular angular orientation and locked in place and the orientation is at an angle to the vertical - the apex 38 on the arm 16 will be aligned with the marker 40, but the structural device can be at any angle - it does not mean that it is definitely vertical because the apex 38 is aligned with the marker 40. The Williams device therefore does not meet the criteria of this claim limitation.

6. The Examiner further stated that a marker 36/40 is disposed on the base and that the marker comprises a detent 36 that projects from the front surface of the base and that the detent includes a second apex shown in Fig. 4 and that the apex of the arm aligns with the second apex of the detent when the structural device is vertical and does not align with the second apex when the structural device is not vertical. Applicant respectfully submits that there is no interaction between the marker 36 and any other component on the Williams device. The component 36 is a bubble level - an entirely self-contained unit that does not need any marker, indicator, apex or anything else to align with it in order to give a reading of levelness. Consequently, aligning anything on the Williams device with the components 36 would not give any useful information to an installer. Furthermore, the bubble levels 36 on the Williams device are oriented to give information regarding horizontal levelness. Anyone who

has used a bubble level knows that a particular bubble level can only be used to indicate "levelness" in one plane. The bubble levels 36 are mounted on base plate 10 to test specifically for horizontal levelness. As a consequence, if base plate 10 was placed on a horizontal surface 35, as is required by Williams, then adjusting the screws 34 would not cause the bubble levels 36 to be oriented in such a way as to measure vertical levelness. The levels 36 would therefore be of no use whatsoever to a fence post installer who is attempting to install a fence post that has to be vertically leveled. The Examiner might then argue that the base plate 10 should be suspended from the post so that the bubble levels 36 could be used to measure vertical levelness. Even if this was done, the bubble levels 36 would not align with anything in order to indicate levelness - they do it all by themselves - the bubble floats between two lines, if it is in those lines the device is level, if it does not fall between those lines then the device is not level. No matter the orientation of base plate 10, the Williams device would not meet the limitation of this claim.

7. Finally, the Examiner stated that alignment of the indicator with said marker indicates that a structural device is vertical and non-alignment of the indicator with the marker indicates that a structural device is not vertical. As previously discussed, the arm 14 does not interact at all with the bubble level 36 and consequently there is no "indicator" "marker" alignment possible. With respect to the arm 16, Williams discloses that

arm 16 be locked into position by the tightened of a thumb screw. Therefore viewing the device and seeing the apex of arm 16 pointing to a marker is not a guarantee that the alignment of the apex and arm is indicating verticalness - because in truth the post could be disposed at any angle and the position of the arm relative to the marker would remain unchanged. Applicant respectfully submits that the only reliable levelness indicator on the Williams device would be the bubble levels 36. So, consequently, if one of ordinary skill in the art were to apply adhesive to a miniaturized version of the Williams device, then that adhesive could only be applied in such a manner that would position the bubble levels on the side wall of the post and the installer would then look at the bubble level to determine if that post were vertical. This would means that one of ordinary skill in the art was entirely using the teachings of Clearly and that the teachings of Williams had not be used at all.

As has been found in *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 52 USPQ 2d 1294, 1298 (Fed. Cir. 1999), if a device modified by the teachings of another is rendered inoperable for its intended purpose then that patent could be considered to teach away from the combination suggested by the Examiner. Applicant respectfully submits that modifying the Williams device by the teachings of Clearly and attempting to use the combined device for the purpose for which Applicant's device has been developed - i.e., mounting the device onto a side wall of a post to indicate vertical levelness, would in fact remove the ability of the Williams device to be horizontally

leveled. This would make it impossible to use the Williams device to test inclinometers and would therefore render the Williams device inoperable for its intended purpose. As a consequence, Applicant respectfully submits that combining the teachings of Williams and Clearly would therefor not be obvious to one of ordinary skill in the art. Applicant therefore respectfully submits that claims 8, 15 and 26-30 are therefore not obvious with respect to Williams in view of Clearly and requests that the rejection of these claims under 35 U.S.C. 103(a) with respect to these references, be withdrawn.

**The Examiner rejected claims 9-10, 14, 22 and 25 under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Clearly and further in view of Elsasser (6,567,756).** The reference to claim 25 was written into the action by hand. However, this claim was previously withdrawn from consideration and consequently Applicant will only address the rejection of claims 9-10, 14 and 22 under 35 U.S.C. 103(a). Clearly teaches that a leveling device be adhesively attached to a post and removed when that post is installed. Elsasser teaches that the post can have a core with a sleeve disposed thereover and Applicant acknowledges that Clearly's device could be used in such an application. However, as argued in response to the previous rejection, Applicant submits that the combination of Williams and Clearly would not be obvious to one of ordinary skill in the art. Therefore, adding the teachings of Elsasser to those of Williams and Clearly would not make the combination obvious. Furthermore, mounting a combined Williams/Clearly device permanently to the core of a post would substantially prevent the sleeve of the post from being received thereover. Applicant respectfully submits that claims 9-10, 14, 22 and 25 are therefore not obvious in light of the Williams, Clearly and Elsasser references and requests that the rejection of the

same with withdrawn.

Applicant hereby respectfully requests reconsideration of claims 1-22 and 26-30 in light of the claim amendments and arguments presented herein.

Respectfully submitted at Canton, Ohio this 9<sup>th</sup> day of November, 2005.

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